Appl. No. 10/695,363
Amdt. dated October 21, 2005
Reply to Office action of August 18, 2005

REMARKS/ARGUMENTS

Applicants have received the Office action dated August 18, 2005, in which the Examiner: 1) restricted the claims into group I (claims 1-9), group II (claims 10-20), and group III (claims 21-24); 2) rejected claims 1, 2 and 4 under 35 U.S.C. § 102(b) as being anticipated by Trost (U.S. Pat. No. 4,288,860); and 3) rejected claims 3 and 5-9 under 35 U.S.C. § 103(a) as being unpatentable over Trost and in view of White (U.S. Pub. No. 2003/0149929).

With this Response, Applicants have amended claim 1 and canceled claim 3. Also, Applicants have withdrawn claims 10-24 in response to the restriction requirement. Claims 1-2 and 4-9 are pending. Based on the amendments and arguments presented herein, Applicants request reconsideration and allowance of the pending claims.

I.   RESTRICTION REQUIREMENT

The Examiner restricted the claims into three groups. Merely to expedite prosecution, Applicants elect Group I (claims 1-2 and 4-9) without traverse, withdraw all other claims, and may file a divisional application for the withdrawn claims.

II.   § 102 AND § 103 REJECTIONS

Claim 1 was amended to incorporate the limitations of canceled claim 3. Amended claim 1, in part, requires "to conserve power, the storage controller modifies operation of the storage system based on a status of the data transfer." Claim 1 further requires that "the storage controller modifies operation of the storage system by turning off a portion of the storage system."

The Examiner recognizes that Trost does not disclose "the storage controller modifies operation of the storage system by turning off a portion of the storage system" as required in claim 1, but asserts that White discloses this limitation. Although White teaches conserving power during a computer's "sleep" mode by reducing the refresh rate of the computer's DRAM (see paragraph [0018] and Figure 1), Applicants submit that the Examiner's assertion is incorrect for at least two reasons.

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First, White's sleep mode and/or reducing the DRAM's refresh rate does not appear to involve "turning off a portion of" the DRAM as suggested by the Examiner. As taught in White, DRAM memory cells need to be periodically refreshed to stay charged (*i.e.*, to stay "on") (see paragraph [0004]). Thus, regardless of the refresh rate, the DRAM memory stays charged (or "on") even in the sleep mode. In contrast, claim 1 requires "the storage controller modifies operation of the storage system by turning off a portion of the storage system."

Second, neither the sleep mode nor reducing the refresh rate as taught in White is "based on a status of the data transfer" as required in claim 1. Rather, the sleep mode is activated when "a predetermined time period has elapsed with no user activity" (see paragraph [0006]). None of the references cited by the Examiner, nor combinations of the references, teaches or suggests "to conserve power, the storage controller modifies operation of the storage system based on a status of the data transfer, wherein the storage controller modifies operation of the storage system by turning off a portion of the storage system" as required in claim 1. For at least these reasons, Applicants submit that claim 1 and all claims that depend from claim 1 are allowable.

In addition to the reasons provided with respect to claim 1, claim 6 requires "the storage controller modifies operation of the storage system by turning off the error correction logic of the storage memory interface in the storage system." White does not clearly teach or suggest this limitation as suggested by the Examiner. As taught in White, error correction code (ECC) encodes critical data when a computer enters a sleep mode. Upon exiting the sleep mode, the ECC decodes the critical data (paragraphs [0012] and [0019]-[0020]). White does not actually teach or suggest "turning off" the ECC as is required in claim 6, but simply describes when the ECC is used (*i.e.*, the ECC may always be on). As explained in MPEP 2112, "the fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic." *In re Rijckaert*, 9 F.3d 1531, 1534. For at least these additional reasons, Applicants submit that claim 6 and all claims that depend from claim 6 are allowable.

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III. CONCLUSIONS

In the course of the foregoing discussions, Applicants may have at times referred to claim limitations in shorthand fashion, or may have focused on a particular claim element. This discussion should not be interpreted to mean that the other limitations can be ignored or dismissed. The claims must be viewed as a whole, and each limitation of the claims must be considered when determining the patentability of the claims. Moreover, it should be understood that there may be other distinctions between the claims and the cited art which have yet to be raised, but which may be raised in the future.

Applicants respectfully request reconsideration and that a timely Notice of Allowance be issued in this case. It is believed that no extensions of time or fees are required, beyond those that may otherwise be provided for in documents accompanying this paper. However, in the event that additional extensions of time are necessary to allow consideration of this paper, such extensions are hereby petitioned under 37 C.F.R. § 1.136(a), and any fees required (including fees for net addition of claims) are hereby authorized to be charged to Hewlett-Packard Development Company's Deposit Account No. 08-2025.

Respectfully submitted,

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